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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/887,272

06/23/2001

Fumiaki Katagiri

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7590

12/02/2005

SYNGENTA BIOTECHNOLOGY, INC.

PATENT DEPARTMENT

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EXAMINER

IBRAHIM, MEDINA AHMED

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/887,272	<b>Applicant(s)</b> KATAGIRI ET AL	
	<b>Examiner</b> Medina A. Ibrahim	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-43 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-33, drawn to an isolated promoter, an expression cassette and host cell comprising said promoter, a plant transformed with said expression cassette, and a method of transforming plant/cells with said polynucleotide or expression cassette, classified in class 800, subclass 278, for example.
- II. Claims 34-40, drawn to a method of transforming a plant with a polynucleotide encoding specific polypeptide sequence and plants/progeny produced by said method, classified in class 800, subclass 279, for example.
- III. Claims 41-43, drawn to a method for identifying and detecting pathogen infection in a plant cell, classified in class 435, subclass 6, for example.

For the invention of Group I, Applicant is also required to elect one of the sequences of SEQ ID NO: 1047, 1051, 1053, 4794, 4892, 5261, 5738, or 6469. For the inventions of Groups II and III, Applicant is also required to elect one of the polynucleotides encoding SEQ ID NO: 50, 139, 609, 4210, 3311, 3791, 2699, 3463, 3584, 4451, or 4595.

The inventions are distinct, each from the other because of the following reasons:

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The promoter sequences of SEQ ID NO: 1047, 1051, 1053, 4794, 4892, 5261, 5738, and 6469 are structurally distinct sequences. Applicant has not shown if these sequences are structurally related (i.e., if they are fragments to each other) to each other. Also, polynucleotides encoding SEQ ID NO: 50, 139, 609, 4210, 3311, 3791, 2699, 3463, 3584, 4451, and 4595 are patentably distinct since each polynucleotide encode a structurally distinct polypeptide. These sequences (promoters or polypeptide encoding sequences) are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 USC 121. Each sequence requires an independent search of the sequence databases. Searching all the promoter sequences or polynucleotides in a single application would create search burden. This requirement is not to be construed as a requirement for an election of species, since each nucleic acid is not a member of single genus invention, but constitute an independent and patentably distinct invention.

Inventions I, II, and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to different products and different methods of using said products. The instant specification does not disclose that these methods would be used together. The invention of Group I requires an isolated promoter with specified sequence and a method of using said promoter to produce transgenic plants, which are not required by any of the other groups. The invention of Group II requires use of a polynucleotide encoding a polypeptide with specific

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sequence, and transformed plants produced by said method, which are not required by any of the other groups. The invention of Group III requires identification and detection methods, and use of probes and binding agents which are not required by any of the other groups. Therefore, inventions I, II, and III are all unrelated as they comprise distinct steps and utilize different products which demonstrates that each method has a different mode of operation. For these reasons, the inventions I, II, and III are patentably distinct.

Furthermore, the distinct steps and products require separate and distinct searches. The inventions of Groups I, II, and III have a separate status in the art as shown by their different classifications. As such, it would be burdensome to search more than one of inventions II or III in a single invention.

Because these inventions are distinct for the reasons set forth above, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM. Before and after final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Amy Nelson, can be reached at (571) 272-0804.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/27/05

Mai

MEDINA A. IBRAHIM  
PATENT EXAMINER

